FILED
MAY 29 1967
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1966

No. 1435

GULF OIL CORPORATION, ADDRESSOGRAPH-MULTIGRAPH CORPORATION, and RALPH COBB, *Petitioners,*

v.

WILLIAM H. WOLOWITZ, *Respondent.*

No.

HUMBLE OIL & REFINING COMPANY, *Petitioner,*

v.

WILLIAM H. WOLOWITZ, *Respondent.*

BRIEF FOR RESPONDENT IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

WILLIAM D. HALL,
ELLIOTT I. POLLOCK,
GEORGE VANDE SANDE,
Attorneys for Respondent.

PRESS OF BYRON S. ADAMS PRINTING, INC., WASHINGTON, D. C.

INDEX

	Page
Statement of the Case	1
The First Question Raised in the Petition Is Based upon Mere Dicta of the District Court and upon An Incorrect Assumption of Facts	4
Petitioner's Second Question is Inapplicable to this case as well as Unsound	6
Summary and Conclusions	8

TABLE OF CASES

Copease Mfg. Co. v. American Photocopy Equipment Co., 298 F.2d 772, 777	6
Graham v. John Deere Co., 383 U.S. 1	6
In re Hortman, 264 F.2d 911, 914	8
Multifastener Corp. v. Ladd, 229 F. Supp. 46, 48	8
Mumm v. Decker & Sons, 301 U.S. 168, 171	6
Samuelson v. Bethlehem Steel Corp., 323 F.2d 944, 947	6
United Shoe Machinery Corp. v. Industrial Shoe Machinery Corp., 335 F.2d 577, 579 (Fn. 2)	6
United States v. Adams, 383 U.S. 39, 52	6
Walt Disney Productions v. Fred A. Niles, Comm. CTR Inc., 369 F.2d 230, 234	6

IN THE

Supreme Court of the United States

OCTOBER TERM, 1966

No.

GULF OIL CORPORATION, ADDRESSOGRAPH-MULTIGRAPH CORPORATION, and RALPH COBB, *Petitioners,*

v.

WILLIAM H. WOLOWITZ, *Respondent.*

No.

HUMBLE OIL & REFINING COMPANY, *Petitioner,*

v.

WILLIAM H. WOLOWITZ, *Respondent.*

BRIEF FOR RESPONDENT IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

STATEMENT OF THE CASE

This is just another patent case, turning, as most such cases do, on questions of fact. It is typical of that class of cases where an individual inventor submitted his invention to a large manufacturer which adopted and used the invention. The District Court emphasized the copying by Defendants (R. 135), and also stressed the fact that Defendants made "a rather ingenious, but unsuccessful, attempt to design around the Wolowitz patent in suit" (R. 141; see also Finding 46 at R. 154).

In their answer to the Complaint, Defendants admitted that they knew of no pertinent prior patents but indicated such would be cited "when they become known to Defendants" (R. 6). We therefore turn to the defenses urged below. These defenses were devised, after the suit was on file, in a desperate effort to justify the flagrant copying of Defendants.

Petitioners limited themselves before the Court of Appeals to the five defenses set forth in their "Statement of Points" on appeal, filed Pursuant to Rule 15 of the Court of Appeals and set forth in a footnote hereto.*

---

* STATEMENT OF POINTS

Pursuant to the provisions of Rule 15 of the General Rules of the United States Court of Appeals for the District of Columbia Circuit the following are the points on which appellants intend to rely on the instant appeals:

1. There was no unexpected result or unusual function and no patentable invention in combining conventional printing wheels with an embossed credit card to print fixed and variable information in a machine-readable code. The court below erred in holding that the Wolowitz patent conferred a monopoly on such unpatentable combination that is embodied in the accused Addressograph data recorder.

2. The objective of the Wolowitz patent was to print the IBM code. The court erred in holding that the compact bar code printed by the accused Addressograph data recorder was equivalent to the IBM code.

3. The Wolowitz patent discloses as its distinguishing mechanical feature a series of transversely movable crossheads for setting individual printing elements or type faces in a pattern across a printing bed. The accused Addressograph data recorder does not have such transversely moving crossheads or any equivalent thereof and does not set printing elements or type faces in a pattern across a printing bed. The court erred in failing to confine the Wolowitz patent to printing machines containing such transversely movable crossheads and equivalents for setting printing elements or type faces in a pattern across the printing bed.

Item 1 of the "Statement of Points" is based on the factual assumption that the accused Addressograph machine involves just two old parts. The description of that machine is plainly incomplete (R. 143-5). Item 1 does not directly attack patent validity but urges that the patent should not cover said two old parts; hence in essence asserts non-infringement.

Item 4 of the "Statement of Points" is the only one dealing with the validity of the patent, and alleges that the patent in suit is anticipated by Hoffman 1,919,219. The District Court dismissed this defense as being "without genuine merit" (R. 136), and Defendants challenged this ruling in the "Statement of Points" on appeal. In the District Court, Defendants also proposed to combine the Hoffman patent with British patent No. 3303, but the District Judge rejected the combination as "impractical" (R. 160), and Defendants thereafter dropped the proposed combination of prior patents as they did not mention said British patent either in their "Statement of Points" or in their brief on appeal.

The points that Petitioners have raised here but which were not covered in their "Statement of Points" on appeal, have, of course, been abandoned, *Aro Mfg. Co.* v. *Convertible Top Replacement Co.*, 377 U.S. 476, 491, Fn. 9.

---

4. The Wolowitz patent was anticipated by expired Hoffman patent No. 1,919,219. The court erred in holding that the defense of anticipation was without genuine merit.

5. The functional claims of the Wolowitz patent, when properly construed in accordance with the file history of the patent and the provisions of 35 U.S.C. § 112, are limited to a printing machine for printing the IBM code and embodying transversely movable assemblies for setting printing elements or type faces in the pattern of the IBM code. The trial court erred in not so limiting the Wolowitz claims.

Dated: August 15, 1966

The First Question Raised in the Petition Is Based Upon Mere Dicta of the District Court and Upon an Incorrect Assumption of Facts

Petitioner reads the decision of the District Court out of context and overlooks the essential holdings of fact. A brief summary of its holdings is as follows (R. 136-9):

The District Court rejected the defense that Plaintiff's patent was anticipated (fully met) as being "without genuine merit", saying that the real question was whether it was obvious to combine references (R. 137). The Court then held that Petitioner's alleged expert Margach was not really an expert at all whereas Plaintiff had produced two qualified experts to show that the proposed combination of references were impractical and unobvious, whereupon the Court concluded (R. 138):

> "The Court finds that the weight of the evidence presented on the technological questions in this case favors the position of Plaintiff Wolowitz that his patent in suit is valid and infringed by the accused Addressograph machine."

Reading this in the light of what the Court said on the preceding page (R. 137), it is clear that the Court was speaking about the question of obviousness. Thus even if the burden of proof were upon the Plaintiff, he proved his case by the "weight of the evidence."

In the next paragraph (R. 138), the District Court in effect said that the evidence in favor of Plaintiff was so clear that even if the Patent Office had rejected the Wolowitz application and Wolowitz had applied

to the District Court to overturn the adverse ruling of the Patent Office, that

> "the Commissioner might well have been authorized [by this Court] to issue such patent" (matter in brackets added).

This in effect was saying that even if a heavy administrative presumption had been adverse to the Plaintiff, the Court still "might well have" ruled for him. Thereupon the District Court made Findings of Fact 52, 53 and 63 to the effect that the proposed combinations of prior patents, if made, would be "impractical" and fell far short of meeting the invention of the claims (R. 155, 160).

In view of the foregoing, it is apparent that the District Court felt that the Wolowitz invention was clearly patentable. That the Patent Office took the same view is plainly shown in the file history of the patent (Def. Ex. 2-U at p. 61) where it is indicated that at an oral interview between the attorney and the Examiner the claims were "agreed upon as clearly allowable". **Thus, Petitioners' extensive discussion of the alleged "rule of doubt" is inapplicable to the facts of the case.**

Petitioner urges that the District Court held that the Patent Office did not "consider" the prior art relied on by Defendant. The Court made no such holding. It merely held that the patents relied on by the Defendants were not "cited" by the Patent Office (R. 162). Considering the fact that the District Court found that the combinations of prior patents were "impractical" (R. 156, 160), it is clear that "the Patent Office representatives qualified in this field did not regard them as sufficiently relevant even to cite",

United Shoe Machinery Corp. v. *Industrial Shoe Machinery Corp.,* CA-1, 335 F. 2d 577, 579 (Fn. 2); *United States* v. *Adams,* 383 U.S. 39, 52; *Copease* v. *American Photocopy Equipment Co.,* CA-7, 298 F. 2d 772, 777.

As for the presumption of validity, 35 U.S.C. 282 provides:

> "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it."

Since the weight of the evidence favored Plaintiff, not Defendant (R. 138), it is unnecessary, as far as this case is concerned, to determine the weight to be given to the presumption. It is noted, however, that numerous courts have held that clear and convincing evidence is required to invalidate a patent, *Mumm* v. *Decker & Sons,* 301 U.S. 168, 171; *Walt Disney Productions* v. *Fred A. Niles, Com. CTR Inc.,* CA-7, 369 F. 2d 230, 234; *Samuelson* v. *Bethlehem Steel Corp.,* CA-5, 323 F. 2d 944, 947.

Petitioner's Second Question Is Inapplicable to This Case as Well as Unsound

The District Court reached the following conclusion (R. 163):

> "3. The Wolowitz patent is valid because the claimed combination of individually old mechanical elements 'as a whole' would not have been obvious at the time Wolowitz made his invention to a person having ordinary skill in the art of business data recording machines. 35 U.S.C. § 103."

This precisely meets the rules of law laid down in *Graham* v. *John Deere Co.,* 383 U.S. 1.

Petitioner makes reference to the holding of the District Court that it is improper to combine references if there is no suggestion in them that they may be combined to produce the inventor's result. The question is not really involved here because no attack upon the validity of the patent, based upon a combination of references, was made in the "Statement of Points" on appeal. But even assuming that such question is before this Court, it is noted that Defendants produced no evidence other than the references themselves in an effort to suggest the combination. The only combination of references urged against the validity of the patent at the trial was Hoffman and British patent No. 3033 (R. 62-3).* Petitioner's alleged expert witness Margach merely said that to put these patents together would be "straightforward engineering" and referred to no facts outside the patents themselves to show that it was obvious to combine them. Without such "outside" facts it is clear, that if the patents themselves did not suggest the combination, that the combination was unobvious.

Petitioner urges that the Court of Appeals of the District of Columbia is in conflict with the Court of Customs and Patent Appeals on the question of combining references. However, the District Court's support for its holding about combining references was

---

* At the trial, Petitioner referred to the combination of Vogt 2,606,494 and British patent 538,016, saying that such combination was the same as the accused Addressograph machine (R. 52-3). Hence this was really a defense of non-infringement. But even if this Court considers this combination of references to be before it, the same discussion that we gave for the Hoffman-British 3033 combination applies, for in presenting the defense Petitioner's witness Margach referred to no facts outside the patents themselves to show obviousness (R. 52-3).

based on its prior decision in *Multi-Fastener Corp.* v. *Ladd,* 229 F. Supp. 46, 48, which, in turn, relied on the Court of Customs and Patent Appeals, which held the same thing, see *In re Hortman* (C.C.P.A.) 264 F. 2d 911, 914:

> "It is well settled that references may not be combined where 'there is no suggestion in either of the references that they can be combined'" * * *

SUMMARY AND CONCLUSIONS

The questions stated by Petitioner are not based on the facts of this case: But even if those questions were involved, the Courts below did not err respecting them.

Respectfully submitted,

WILLIAM D. HALL,
ELLIOTT I. POLLOCK,
GEORGE VANDE SANDE,
Attorneys for Respondent.